

## United States Patent and Trademark Office



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	10/089,819 08/08/2002		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO. 5592	
10/089,819			John Hughes	A0000005/1-01-MG		
7590 01/22/2007 Mehdi Ganjeizadeh				EXAMINER		
Warner Lambe	rt Company	CHONG, YONG SOO				
2800 Plymouth Road Ann Arbor, MI 48105				ART UNIT	PAPER NUMBER	
				1617		
		•		MAIL DATE	DELIVERY MODE	
				01/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Advisory Action Before the Filing of an Appeal Brief

Application No.	Applicant(s)
10/089,819	HUGHES ET AL.
Examiner	Art Unit
Yong S. Chong	1617

3. ☑ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because  (a) ☑ They raise new issues that would require further consideration and/or search (see NOTE below);  (b) ☑ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE: (See 37 CFR 1.116 and 41.33(a)).  4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  5. ☐ Applicant's reply has overcome the following rejection(s):  6. ☐ Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  Claim(s) allowed:		Yong S. Chong	1617	
1. ☑ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or or revience, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal se) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:  a) ☑ The period for reply expires on: (1) the mailing date of the final rejection.  b) ☐ The period for reply expires on: (1) the mailing date of the final rejection.  Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MEPE 706.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final drejection, even if timely flex, and the final rejection of the date of filing the Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within the final rejection of filing the Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within the filing a file filing a filing the filing a filing and filing a	The MAILING DATE of this communication appear	ars on the cover sheet with the c	correspondence add	ress
1. ☑ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or or revience, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal se) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:  a) ☑ The period for reply expires on: (1) the mailing date of the final rejection.  b) ☐ The period for reply expires on: (1) the mailing date of the final rejection.  Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MEPE 706.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final drejection, even if timely flex, and the final rejection of the date of filing the Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within the final rejection of filing the Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within the filing a file filing a filing the filing a filing and filing a	THE REPLY FILED 01 August 2006 FAILS TO PLACE THIS AF	PPLICATION IN CONDITION FOR	ALLOWANCE.	
a) Some period for reply expires 2_months from the mailing date of the final rejection, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire set for than SIX MONTHS from the mailing date of the final rejection.  Examiner Note: If box 1 is checked, check either box (a) or (b) ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 705 07().  Extensions of time may be obtained under 37 CFR 1.13(s) and the period of extension and the corresponding amount of the fee. The appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely any reduce any earned patent term adjustment. Sea 37 CFR 1.704(b).  NOTICE OF APPEAL.  2. The Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37(a); to avoid dismissal of the appeal. Since a Notice of Appeal mas been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  AMENDMENTS  3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing the visit of the period of actions of the period of the period of Appeal (37 CFR 41.37(a)).  AMENDMENTS  (a) They raise new issues that would require further consideration and/or search (see NOTE below);  (b) They raise the issue of new matter (see NOTE below);  (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d) They present additional claims without cancelling a corresponding number of finally rejected claims.  NOTE: (See 37 CFR 1.116 and 41.33(a)).  1. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTCL-324).  3. The a	1.   The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliance.	the same day as filing a Notice of ving replies: (1) an amendment, aftice of Appeal (with appeal fee) in the contract of the c	Appeal. To avoid aba fidavit, or other evider compliance with 37 C	nce, which FR 41.31; or (3)
no event, however, will the statutiory period for reply expire later than SIX MONTHS from the mailing date of the finite risection.  Extensions of time may be obtained under 37 CFR 1.38(a). The date on which the petition under 37 CFR 1.38(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as et forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.70(b).  NOTICE OF APPEAL  1. The Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal as been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  ANENDMENTS  3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (a) They raise new issues that would require further consideration and/or search (see NOTE below);  (b) They raise the issue of new matter (see NOTE below);  (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d) They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE: (See 37 CFR 1.116 and 41.33(a)).  4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  5	·	of the final rejection.		
Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the. The appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (3) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reply as a consideration and the proposed and the propo	no event, however, will the statutory period for reply expire la Examiner Note: If box 1 is checked, check either box (a) or (	ater than SIX MONTHS from the mailin b). ONLY CHECK BOX (b) WHEN THI	g date of the final reject	on.
<ul> <li>2.</li></ul>	Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of extunder 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office later may reduce any earned patent term adjustment. See 37 CFR 1.704(b)	on which the petition under 37 CFR 1.1 tension and the corresponding amount shortened statutory period for reply origon than three months after the mailing date.	of the fee. The approprially set in the final Off	iate extension fee ice action; or (2) as
AMENDMENTS 3. ☑ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (a) ☑ They raise new issues that would require further consideration and/or search (see NOTE below); (b) ☑ They raise the issue of new matter (see NOTE below); (c) ☑ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE:	<ol> <li>The Notice of Appeal was filed on A brief in comp filing the Notice of Appeal (37 CFR 41.37(a)), or any exter</li> </ol>	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of the	
(a)	<u>AMENDMENTS</u>	•	,	
non-allowable claim(s).  7. For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  Claim(s) allowed:  Claim(s) objected to:  Claim(s) rejected:  Claim(s) withdrawn from consideration:  AFFIDAVIT OR OTHER EVIDENCE  8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).  13. Other:	<ul> <li>(a) ☐ They raise new issues that would require further co</li> <li>(b) ☐ They raise the issue of new matter (see NOTE belo</li> <li>(c) ☐ They are not deemed to place the application in bet appeal; and/or</li> <li>(d) ☐ They present additional claims without canceling a NOTE: (See 37 CFR 1.116 and 41.33(a)).</li> <li>4. ☐ The amendments are not in compliance with 37 CFR 1.11</li> </ul>	nsideration and/or search (see NOw); w); ter form for appeal by materially re corresponding number of finally re 21. See attached Notice of Non-Co	TE below); educing or simplifying jected claims.	the issues for
how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  Claim(s) allowed:  Claim(s) objected to:  Claim(s) rejected:  Claim(s) withdrawn from consideration:  Claim(s) withdrawn from consideration:  AFFIDAVIT OR OTHER EVIDENCE  8. ☑ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)	non-allowable claim(s).			
<ul> <li>8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</li> <li>9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</li> <li>10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</li> <li>REQUEST FOR RECONSIDERATION/OTHER</li> <li>11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.</li> <li>12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)</li> <li>13.  Other:</li> </ul>	how the new or amended claims would be rejected is profile that status of the claim(s) is (or will be) as follows:  Claim(s) allowed:  Claim(s) objected to:  Claim(s) rejected:  Claim(s) withdrawn from consideration:		ill be entered and an	explanation of
entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  13. Other:	8.  The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good an	it before or on the date of filing a N d sufficient reasons why the affida	lotice of Appeal will <u>n</u> vit or other evidence i	ot be entered s necessary and
REQUEST FOR RECONSIDERATION/OTHER  11. ☑ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  13. ☐ Other:	<ol> <li>The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to o showing a good and sufficient reasons why it is necessar</li> </ol>	overcome <u>all</u> rejections under appe y and was not earlier presented. S	eal and/or appellant fa See 37 CFR 41.33(d)(	ils to provide a 1).
See Continuation Sheet.  12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  13. Other:	•	n of the status of the claims after e	entry is below or attac	hed.
13. Other:	•	it does NOT place the application i	in condition for allowa	nce because:
Monare Haryong S. Chong	<ul><li>12. ☐ Note the attached Information Disclosure Statement(s).</li><li>13. ☐ Other:</li></ul>	(PTO/SB/08) Paper No(s)		
		Modmanest	Yong S. Chong	

SREENI PADMANABHAN SUPERVISORY PATENT EXAMINER Continuation of 11. does NOT place the application in condition for allowance because: The compound in claims 1, 4, and 21, [2-(1H-indol-yl)-1-methyl-1-(1-phenyl-ethylcarbamoyl)-ethyl]-carbamic acid benzofuran-2-ylmethylester [R-(R\*,S\*)] is not supported by Applicant's disclosure. Accordingly, the compound in claims 7-8, [2-(1H-indol-3-yl)-1-methyl-1-(1-phenyl-ethylcarbamoyl)-ethyl]-carbamic acid benzofuran-2-ylmethylester [R-(R\*,S\*)] lacks antecedent basis. Finally, it is not clear if the character after the 'methyl' in either of the compounds listed above is a "1, I or [."